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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/755,080	01/10/2004	M. Samy Abdou	110447-000002	8186
27189	7590	04/05/2006	EXAMINER	
PROCOPIO, CORY, HARGREAVES & SAVITCH LLP			BAXTER, JESSICA R	
530 B STREET			ART UNIT	
SUITE 2100			PAPER NUMBER	
SAN DIEGO, CA 92101			3733	

DATE MAILED: 04/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/755,080	<b>Applicant(s)</b> ABDOU, M. SAMY	
	<b>Examiner</b> Jessica R. Baxter	<b>Art Unit</b> 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-9, 15-24, 33 and 34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 15-24, 33 and 34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-24, 33 and 34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant has failed to disclose the active control of the modular movement of the plating system.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-9, 15-19, 21, 24, 33 and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,616,142 to Yuan et al.

Yuan discloses a plating system for bone fixation for mammalian bone structures,

comprising: (a) a first plate segment and a second plate segment (FIGS. 1 and 2), each of the segments adapted to be affixed onto a bone structure with another bone structure in an aligned spatial relationship (Column 1 lines 34-38); (b) a coupler means (coupling segment) being securable to the first plate segment and the second plate segment (piece 20'), the coupler means being selectively adjustable to define the movement (compression and subsidence) of the bone structures in the aligned spatial relationship; wherein the coupler means is selectively adjustable to enable compression and subsidence of the bone structures in the aligned spatial relationship (sliding nature of pieces allows the compression/subsidence) ; wherein the plates are slidably engaged substantially in the aligned spatial relationship (FIG. 1 and 2); wherein each of the plates has a projection portion and a receiving channel for complementary placement of the projection portion of one plate segment into the receiving channel of another plate segment; wherein the first plate segment has at least one projection portion and the second plate segment has at least one receiving channel to receive the projection portion of first plate segment; wherein the projection portion has a generally elongated body with cross-section shape selected from the shapes of a triangle, truncated triangle, rectangle, modified rectangle, and a trapezoid (FIG. 2 cross-section of sliding pieces); wherein the coupler means is selectively engaged with first plate segment and the second plate segment to secure one or both the plate segments to define the movement of the bone structures in the aligned spatial relationship; wherein the coupler means comprises an elongated element and a plurality of fasteners (openings 22 receive fasteners) for selectively engaging the plating segments; wherein the coupler means has an opening (openings 22) to receive at least one fastener passing therethrough; wherein the plate segments each has at least one opening (openings 12 and 12') to accommodate a bone screw

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for securing the plate segments onto the bone structures; wherein the plate segments each has at least one opening, wherein each of the plate segments has curved surfaces to conform to the surface contours of the bone structures (FIG. 4c).

5. Claims 1-9, 15-24,33 and 34 are rejected under 35 U.S.C. 102(e) as being anticipated by PG-Pub 2002/0183755 to Michelson.

Michelson discloses a plating system for bone fixation for mammalian bone structures, comprising: (a) a first plate segment and a second plate segment, each of the segments adapted to be affixed onto a bone structure with another bone structure in an aligned spatial relationship; (b) a coupler means (coupling segment) being securable to the first plate segment and the second plate segment, the coupler means being selectively adjustable to define the movement (compression and subsidence) of the bone structures in the aligned spatial relationship; wherein the coupler means is selectively adjustable to enable compression and subsidence of the bone structures in the aligned spatial relationship (Paragraphs 0008-0010); wherein the plates are slideably engaged substantially in the aligned spatial relationship; wherein each of the plates has a projection portion and a receiving channel for complementary placement of the projection portion of one plate segment into the receiving channel of another plate segment; wherein the first plate segment has at least one projection portion and the second plate segment has at least one receiving channel to receive the projection portion of first plate segment (FIG. 30A); wherein the projection portion has a generally elongated body with cross-section shape selected from the shapes of a triangle, truncated triangle, rectangle, modified rectangle, and a trapezoid, wherein the coupler means is selectively engaged with first plate segment and the second plate segment to secure one or

both the plate segments to define the movement of the bone structures in the aligned spatial relationship; wherein the coupler means comprises an elongated element and a plurality of fasteners for selectively engaging the plating segments; wherein the coupler means has an opening to receive at least one fastener passing therethrough to engage one or both of the plate segments; wherein the coupler means comprises stepped channel openings formed on the first plate segment and the second plate segment and arranged in a substantially overlapping relationship and defining an internal travel pathway between the first and the second plate segments; a bolt element having a threaded shank portion passing through the stepped channel openings with locking mechanisms at the ends of the shank to secure the plate segments; and a frictional element fitted in the internal travel pathway and engageable by the threaded shank portion to couple the bolt element to either the first plate segment or the second plate segment; wherein the bolt element and the of the openings of the stepped channels are of substantially similar width; wherein at least a portion of the frictional element and the internal travel pathway are of substantially similar width; wherein the plate segments each has at least one opening; wherein the plate segments each has at least one opening; wherein at least a portion of the plating segments is constructed of a biologically adaptable or biologically compatible material; wherein the biologically adaptable or biologically compatible material is selected from the group of materials consisting of stainless steel, titanium, combination metallic alloys, plastics, ceramics, osteo-conductive materials, and bio-active materials; wherein the osteo-conductive material is a demineralized bone matrix, a hydroxyapatite, a transforming growth factor, platelet-derived growth factor or a bone-morphogenic protein (Paragraph 0206); wherein each of the plate segments has curved surfaces; wherein each of the plate further comprises an end coupler adaptable to be engaged

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by a distraction screw; wherein the end coupler includes means for engagement with the distraction screw comprising interfitting threads or complementary spines (Paragraphs 0186-0205).

### ***Response to Arguments***

6. Applicant's arguments filed 03 January 2006 have been fully considered but they are not persuasive.

7. In response to applicant's argument that the limitation "being selectively adjustable to actively control the modular movement", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The structures of Yuan and applicant's claimed device are the same. The limited motion of Yuan's device is sufficient to control the vertebral motion by limiting the movement of each vertebra.

8. In response to applicant's argument that the limitation "being selectively adjustable to actively control the modular movement", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The structures of Michelson and applicant's claimed device are the same. The limited motion of Michelson's device is sufficient to control the vertebral motion by limiting the movement of each vertebra.

***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica R. Baxter whose telephone number is 571-272-4691. The examiner can normally be reached on M-F 8:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

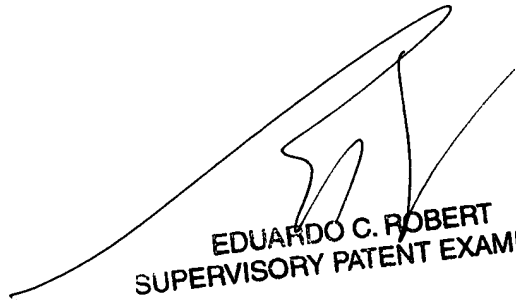


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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
jrb

Jessica R Baxter  
Examiner  
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EDUARDO C. ROBERT  
SUPERVISORY PATENT EXAMINER